

Application No.: 10/807,224
Attorney Docket No.: 25384A

REMARKS

Claim 6 has been canceled without prejudice and not for any reason related to patentability. Applicants respectfully submit that this amendment is proper despite the finality of the outstanding Office Action because the amendments place the application in condition for allowance and/or place the application in better form for appeal. No question of new matter arises and entry of the amendment is respectfully requested.

Claims 1 – 5, 7 and 21 – 28 are before the Examiner for consideration.

Claim Objection

Claim 6 has been objected to as failing to further limit the subject matter of a previous claim. In particular, the Examiner states that claim 6 requires that the binder composition has a pre-binder composition:co-binder ratio from 90:10 to 25:75 and that claim 1 requires that the co-binder be present in the composition in an amount of at least about 50%. Thus, the Examiner states that claim 6 fails to further limit claim 1.

In response to this objection, Applicants have canceled claim 6 without prejudice, thereby rendering this objection moot. Accordingly, Applicants respectfully request that this objection be reconsidered and withdrawn.

Rejection under 35 U.S.C. §103(a)

Claims 1 - 7 and 21 - 28 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application No. 2004/0122166 to O'Brien-Bernini, *et al.* ("O'Brien-Bernini") in view of U.S. Patent No. 5,026,746 to Floyd *et al.* ("Floyd"). It is asserted that O'Brien-Bernini discloses a polyacrylic acid based binder composition that includes a polyacrylic acid, a crosslinking agent (e.g., triethanolamine or glycerol), a catalyst (e.g., sodium hypophosphate or sodium phosphate), and an extender such as maltodextrin. It is further asserted that the maltodextrin:polyacrylic acid ratio is set at 1%, 5%, 15%, 30%, and 45%. The Examiner admits that O'Brien-Bernini does not disclose that the co-binder is present in an amount of at least 50% and that the dextrin may be yellow dextrans, white dextrans, and/or British gums. In this regard, Floyd is cited as disclosing a starch based composition for non-woven fibers or fabrics made of fiberglass. The Examiner asserts that the ratio of monomer to starch can be varied from 1:50 to about 15:1. It is also asserted that white dextrans, canary dextrans, and British gums are the preferred dextrans. The Examiner

Application No.: 10/807,224
Attorney Docket No.: 25384A

concludes that it would have been obvious to use Floyd's disclosure that the co-binder is present in an amount of at least about 50% and that the pre-binder is present in an amount from 1 – 50% in the composition of O'Brien-Bernini to create a composition that would reduce the stretching of the fibrous material and that would improve the water resistance of the article. The Examiner also states that it would have been obvious to use white dextrans, canary dextrans, and British gums as taught by Floyd as the dextrans in O'Brien-Bernini to create a binder composition with improved recovery.

Initially, Applicants submit that claim 6 has been canceled without prejudice, thereby rendering the rejection of this claim moot.

Additionally, Applicants note that U.S. Patent Application No. 2004/0122166 to O'Brien-Bernini issued as U.S. Patent No. 7,026,390 on April 11, 2006.

In response to this rejection, Applicants note that in applications filed on or after November 29, 1999, subject matter that was prior art under former 35 U.S.C. §103 via U.S.C. §102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention were owned by the same person or subject to an obligation of assignment to the same person at the time that the later invention was made.¹ In the instant rejection, U.S. Patent Application No. 2004/0122166 (now U.S. Patent No. 7,026,390) is being applied as prior art under 35 U.S.C. §102(e).

Applicants submit that U.S. Patent Application No. 2004/0122166 (now U.S. Patent No. 7,026,390) is assigned to Owens Corning Composites SPRL (Reel/Frame 015662/0328) and that the present application is assigned to Owens-Corning Fiberglas Technology, Inc. (Reel/Frame 013769/0623). Applicants respectfully submit that both Owens Corning Composites SPRL and Owens Corning Fiberglas Technology, Inc. are wholly owned subsidiaries of Owens Corning. Therefore, all patents of Owens Corning Composites SPRL and Owens Corning Fiberglas Technology, Inc. are owned by Owens Corning. In this regard, the undersigned hereby represents that both U.S. Patent Application No. 2004/0122166 (U.S. Patent No. 7,026,390) to O'Brien-Bernini and the claimed invention were, at the time the invention set forth in the present application was made, were owned by, or subject to an obligation of assignment, to Owens Corning.

¹ See, e.g., American Inventors Protections Act of 1999 (AIPA), 1241 O.G. 96, December 26, 2000 and MPEP 706.02(I)(1).

Application No.: 10/807,224
Attorney Docket No.: 25384A

In view of the above, Applicants submit that U.S. Patent Application No. 2004/0122166 (U.S. Patent No. 7,026,390) to O'Brien-Bernini is not effective prior art against the present application. Therefore, Applicants respectfully request that this rejection be reconsidered and withdrawn.

Conclusion

In light of the above, Applicants believe that this application is now in condition for allowance and therefore request favorable consideration.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

If necessary, the Commissioner is hereby authorized to charge payment or credit any overpayment to Deposit Account No. 50-0568 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

Date:

May 22, 2006


Margaret S. Millikin
Registration No. 38,969

Owens Corning
Patent Department, Bldg. 11
2790 Columbus Road
Granville, Ohio 43023
(740) 321-5359